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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

POLLACK, MELVIN H

ART UNIT

PAPER NUMBER

2141

12

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,723

Applicant(s)

YOSHIZAWA, HIROYUKI

Examiner

Melvin H Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached office action.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04 February 2004 has been entered.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is too short. Correction is required. See MPEP § 608.01(b).

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1, 3, 11, 21-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. The examiner is of the opinion that applicant failed to correctly cancel claim 3, and this has resulted in unintended redundancy, which automatically causes indefiniteness.

Therefore, the applicant should submit an amendment that properly delineates whether claim 3 is cancelled, preferably by writing “3. (Cancelled)” in the claims, rather than “3. (Previously Presented)...”

8. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “when an error, between the image information and prestored image information, is within a predetermined range” in claims 1, 11, and 21-28 are used by the claims to mean “when the image information matches prestored information within a respectable range of error”, while the accepted meaning is “the error has a range.” The term is indefinite because the specification does not clearly redefine the term. Further, an error cannot have a range; it is either an error or it is not. Further, why would a message be transmitted if and only if an error occurred? The

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examiner urges the applicant to amend the claims to better clarify this phrase, and to better explain how the comparison is performed and for what purpose.

9. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 8 recites the broad recitation "character, image *and/or* audio information," and the claim also recites, "parameter includes, " which is the narrower statement of the range/limitation. Further, the term "and/or" is also indefinite and must be removed. The examiner suggests rewriting this claim to state "the parameter comprises (or consists of, or includes) at least one of the following information types: character, image, and audio."

10. Claims 1, 11, and 21-28 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the

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elements. See MPEP § 2172.01. The omitted elements are: the precise structure and use of the elements listed in claim 1. To explain, it is unclear why a sender would set a block to filter his or her own messages, but let us assume that it is for some authentication purpose. By comparing prestored image information with the image information within an electronic signature file, as the term is understood by those skilled in the art, you are simply comparing two previously saved images (or image information), as electronic signatures are previously composed and saved files, especially as separate from digital signatures. Actually, an electronic signature file as currently defined could be considered all or part of the e-mail, such as a header or attached vCard. As such, it is a lousy authentication device because an unauthorized user could use the computer later and simply attach the signature file saved on the hard drive. As for the image generator, the term is too broad to automatically be considered a camera or image capturing device – it could simply be a component to create or import the signature – but let us assume that it is a camera. In this instance, the captured picture would not be a signature file as currently known in the art and agreed upon in prior office actions. Furthermore, there is no functional reason why said image would have to be part of the email, as it is the sending unit that performs the filtering operations. The examiner has determined that, to properly rule on the precise design, operation, and usage of the invention, these gaps must be amended into the independent claims, or at least clarification made regarding these issues.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 4, 10-12, 20, 23, 24, 26, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glass et al. (6,332,193) in view of Uomini (6,018,761).

13. For claim 1, Glass teaches an electronic apparatus (abstract) comprising a transmitter (Fig. 2, #4) transmitting electronic mail (Fig. 7, #17) in which a symbol including image information (Fig. 2, #6), which enables a sender to be specified therefrom (col. 1, lines 10-20), is included within an electronic signature file (col. 5, line 65 – col. 6, line 9), wherein said transmitter transmits the electronic mail only when an error, between the image information and prestored image information, is within a predetermined range (col. 1, lines 40-47; col. 9, lines 50-55).

14. The above teaches that the purpose is to secure access to various types of secured resources. Examiner takes Official Notice (see MPEP § 2144.03) that “one of these resources is electronic mail” in a computer networking environment was well known in the art at the time the invention was made. There is a large body of art devoted to ensuring that the sender of a message is who he claims to be, using a wide variety of authentication schemes. One example would be an electronic stamp method, while another would be an ISP and header filter. Further, Glass teaches a method of internet shopping (col. 8, lines 30-33), in which one may make a purchase through a simple e-mail. At the time the invention was made, one of ordinary skill in the art would have studied the Glass biometric system as a way to secure e-mail access as a replacement for passwords and other authentication schemes.

15. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d

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724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

16. Glass does not expressly disclose that the image is included within an electronic signature file of the electronic mail, said electronic signature file including an email address of the sender. Uomini teaches a method (see abstract) of studying e-mails for further context, in which signatures of various types are analyzed (col. 2, lines 7-16 and 28-55). At the time the invention was made, one of ordinary skill in the art would have combined the two inventions in order to better develop a digital signature that would be harder to manipulate (Glass, col. 7, line 65 – col. 8, line 13).

17. For claim 2, Glass teaches a generator generating the image information by inputting an image of the sender (Fig. 2, #6).

18. For claim 4, Glass teaches that the image information includes an image related to at least a face of the sender (Fig. 2, Scene). In this embodiment, Glass teaches that the image is of an eye, for retinal scanning, and the eye is related to the face of the sender. Further, it is well known in the art that some biometric methods use an image of the entire face or body.

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19. For claim 10, Glass does not expressly disclose that the symbol includes information affording linking to the sender. Uomini teaches this limitation (Fig. 2b). At the time the invention was made, one of ordinary skill in the art would include this information so that the receiver could recognize the sender (col. 1, lines 45-50) and so that the recipient can gain valuable information regarding whether to do business with the sender (col. 2, lines 18-25).

20. Claim 11 drawn to the limitations in claim 1. Claim 11 adds a display, which Glass also teaches (Fig. 7, #2). Therefore, since claim 1 is rejected, claim 11 is also rejected for the reasons above.

21. Claim 12 is drawn to the limitations in claim 4. Therefore, since claim 4 is rejected, claim 12 is also rejected for the reasons above.

22. Claim 20 is drawn to the limitations in claim 10. Therefore, since claim 10 is rejected, claim 20 is also rejected for the reasons above.

23. Claims 23 and 24 are drawn to the limitations in claims 1 and 11, respectively. Therefore, since claims 1 and 11 are rejected, claims 23 and 24 are also rejected for the reasons above.

24. Claims 26 and 27 are drawn to a software system that implements the method drawn in claims 1 and 11. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 1 and 11 are rejected, claims 26 and 27 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

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25. Claims 5-9, 13-19, 21, 22, 25, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glass and Uomini as applied to claim 1, 11 above, and further in view of Sundsted (5,999,967).

26. For claim 5, neither Glass nor Uomini discloses an adding unit adding to the electronic signature file a parameter which indicates an importance of the electronic mail. Sundsted teaches a method (see abstract) of e-mail authentication security (col. 1, lines 5-10) in which an electronic stamp is used to show identity (col. 3, lines 25-45), and in which the stamp is attached to the e-mail and acts as a digital signature (col. 11, lines 20-30 in view of col. 7, lines 10-25). This stamp, acting as a signature file, also includes the priority of the message (col. 3, lines 45-52). At the time the invention was made, one of ordinary skill in the art would have added a Sundsted system as a method of assisting the receiver in determining the mail's importance (col. 3, lines 15-21).

27. For claim 6, neither Glass nor Uomini discloses the parameter indicates the importance of the electronic mail by a display format of the electronic signature file. Sundsted teaches this limitation as well (Fig. 4, #41). At the time the invention was made, one of ordinary skill in the art would have added a Sundsted system as a method of assisting the receiver in determining the mail's importance (col. 3, lines 15-21).

28. For claim 7, neither Glass nor Uomini discloses that the parameter includes information which indicates a display priority order of the electronic mail. Sundsted teaches this limitation (col. 8, lines 30-36). At the time the invention was made, one of ordinary skill in the art would have added a Sundsted system as a method of assisting the receiver in determining the mail's importance (col. 3, lines 15-21).

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29. For claim 8, Uomini discloses that the parameter includes character, image and/or audio information indicating a summary of the electronic mail (col. 2, lines 39-42). At the time the invention was made, one of ordinary skill in the art would have added Uomini to Glass in order to provide a standard mail context study system (col. 1, lines 9-10).

30. For claim 9, neither Glass nor Unomi expressly discloses that the information which indicates the display priority order of the electronic mail includes at least one of a display position and a display timing of the electronic signature file. Sundsted teaches this limitation (col. 10, line 65 – col. 11, line 7). At the time the invention was made, one of ordinary skill in the art would have added a Sundsted system as a method of assisting the receiver in determining the mail's importance (col. 3, lines 15-21).

31. Claims 13 and 16 are drawn to the limitations in claim 5. Therefore, since claim 5 is rejected, claims 13 and 16 are also rejected for the reasons above.

32. Claim 14 is drawn to the limitations in claims 5 and 6. Therefore, since claims 5 and 6 are rejected, claim 14 is also rejected for the reasons above.

33. Claims 15 and 18 are drawn to the limitations in claim 7. Therefore, since claim 7 is rejected, claims 15 and 18 are also rejected for the reasons above.

34. Claim 17 is drawn to the limitations in claim 9. Therefore, since claim 9 is rejected, claim 17 is also rejected for the reasons above.

35. Claim 19 is drawn to the limitations in claim 8. Therefore, since claim 8 is rejected, claim 19 is also rejected for the reasons above.

36. Claim 21 is drawn to the limitations in claims 11 and 13. Therefore, since claims 11 and 13 are rejected, claim 21 is also rejected for the reasons above.

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37. Claim 22 is drawn to the limitations in claims 1 and 5. Therefore, since claims 1 and 5 are rejected, claim 22 is also rejected for the reasons above.

38. Claim 25 is drawn to the limitations in claims 11 and 14. Therefore, since claims 11 and 14 are rejected, claim 25 is also rejected for the reasons above.

39. Claim 28 is drawn to a software system that implements the method drawn in claims 11 and 14. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 11 and 14 are rejected, claim 28 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

Conclusion


40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
16 April 2004


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SUPERVISORY PATENT EXAMINER